REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, <u>the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits</u>.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 103

Claims 1-3, 20-23 and 39-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0010757 ("the Granik publication") in view of U.S. Patent Application Publication No. 2003/0101271 ("the Smith publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Granik publication concerns an *advertisement replacement system* which:

> functions to parse downloaded
> web-page code containing undesired
> advertisement content and filter out

-12-

> the undesired advertising content by
> preventing it from being displayed,
> and then replaces the filtered out
> web-based advertising with
> personalized and more appropriate
> content, i.e. other advertisements or
> information. As will be described in
> greater detail herein, the
> advertising content or information
> that is replaced by the client
> application may be based on user
> profile information....

(Paragraph [0018] of the Granik publication) More
specifically, the portion of the Granik publication cited
by the Examiner provides:

> As shown in FIG. 1, the ad
> replacer cluster 25 further includes
> a re-direct server 27 which functions
> to re-direct a user ad click to its
> final destination. That is, when a
> web user clicks on an ad replaced by
> the Ad Replacer software, a link will
> take the user to the re-direct server
> 27. ***Particularly, in response to a
> user click on a replaced ad, a
> web-based communication 32 is
> generated that includes a re-direct
> ad URL including***: 1) an encrypted
> identifier that identifies the user
> on the re-direct server; and 2) an
> ***ultimate destination website code.***
> [Emphasis added.]

(Paragraph [0043] of the Granik publication) As can be
appreciated from the foregoing, the Granik publication
describes a system which allows client web browsers to
replace advertisements which have already been served to
the client web browser with new advertisements based on
user profile information for presentment to the user,
such that, in response to a user click on a replaced ad,

-13-

a web-based communication is generated that includes a
re-direct ad URL including: 1) an encrypted identifier
that identifies the user on the re-direct server; and 2)
an ultimate destination website code (an ad landing
page).

Regardless of the absence or presence of motivation
to combine, claims 1-3, 20-23 and 39-42 are not rendered
obvious by the Granik and Smith publications since these
claims recite features not included in the combination of
the Granik and Smith publications proposed by the
Examiner. More specifically, independent claims 1 and 20
are not rendered obvious by the cited references because
neither the Granik publication, nor the Smith
publication, either taken alone or in combination,
teaches or suggests acts of encoding or decoding one or
more ad properties included in a click URL *wherein the
one or more encoded ad properties include at least one of
(1) information indicating how the ad was served, (2)
information indicating advertiser charges, and (3)
information indicating how the ad was selected as a
candidate for serving*. In rejecting claim 1, the
Examiner concedes that:

> Granik does not teach that the one or
> more encoded ad properties include at
> least one of (1) information
> indicating how the ad was served, (2)
> information indicating advertiser
> charges, and (3) information
> indicating how the ad was selected as
> a candidate for serving.

(Paper No. 20080702, page 3) However, the Examiner
contends that the Smith publication teaches this feature
since it provides that:

-14-

> [i]n addition to encoding user
> information and document information
> with the URL, the server also encodes
> delivery parameters, or transaction
> identifiers in the URL.

(Paper No. 20080702, page 3) The applicants respectfully
disagree.

The encoded delivery parameters described in the
Smith publication do not teach the recited ad properties
included in the click URL recited in claims 1 and 20.
Specifically, the Smith publication describes the
optional delivery parameters as follows:

> Users of senders 16 can also use the
> advanced options user interface 192
> to customize their *delivery options*,
> including, for example, security
> options and receipt requirements. For
> example, if the user 16 desires to
> customize the security options,
> including private and or public key
> encryption, the user simply checks a
> "Public Encrypt" or "Private Encrypt"
> option. Similarly, the user can
> select the "Notify on Receipt"
> option, thus informing the BFD server
> 12 to confirm delivery when the
> document is actually received.

(Paragraph [0111] of the Smith publication) As can be
appreciated from the forgoing, the delivery parameters
include options on whether to use encryption to retrieve
a document *which has not yet been retrieved* or whether to
notify the sender when a recipient has received a
document. However this does not teach that the ad
properties include at least one of (1) information
indicating how the ad was served, (2) information

-15-

indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving as described in the present application.

By contrast, in the claimed invention, information indicating **how the ad was served** may include, for example, a time the ad was served, a time the ad was rendered, a rendering attribute of the ad, a position of the ad within a Web page, information about other ads that were rendered along with the ad, and a geolocation to which the ad was served. (See claims 3 and 22 of the present application.) Information indicating **advertiser charges** may include, for example, a price that the advertiser will be charged for the impression, a price that the advertiser will be charged for a click, and a price that the advertiser will be charged for a conversion. (See claims 39 and 41 of the present application.) Information indicating **how the ad was selected as a candidate for serving** may include, for example, search conditions that generated the page with which the ad was rendered, a topic of the content with which the ad was served, a concept of content with which the ad was served, and an identity of the content with which the ad was served. (See claims 40 and 42 of the present application.) As can be appreciated from the foregoing, the delivery parameters described in the Smith publication do not teach the ad properties include at least one of (1) information indicating how the ad was served, (2) information indicating advertiser charges, and (3) information indicating how the ad was selected as a candidate for serving as described in the present application.

-16-

Thus, claims 1 and 20 are not rendered obvious by the Granik and Smith publications for at least this reason. Since claims 2, 3, 39 and 40 depend from claim 1, and since claims 21-23, 41 and 42 depend from claim 20, these claims are similarly not rendered obvious by the Granik and Smith publication.

Claims 4-9 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik and Smith publications, further in view of the paper, T. Berners-Lee, et al, "Uniform Resource Identifiers (URI): General Syntax," Network Working Group, Request for Comments: 2396, (August 1998) ("RFC 2396"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 4-9 and 23-28 directly or indirectly depend from claims 1 and 20, respectively. The purported teachings of RFC 2396 would not compensate for the deficiencies of the Granik and Smith publications with respect to claims 1 and 20, discussed above, regardless of the scope of the purported disclosure in RFC 2396, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 4-9 and 23-28 are not rendered obvious by the cited references for at least this reason.

Claims 10-12, 19, 29-31 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Granik publication in view of U.S. Patent Application Publication No. 2003/0035139 ("the Tomita publication"). The applicants respectfully request that the Examiner

-17-

reconsider and withdraw this ground of rejection in view of the following.

First, one skilled in the art would not have been motivated to combine the Granik and Tomita publications as proposed by the Examiner. As already discussed above, the Granik publication generally concerns "[a]n Internet/world-wide-web-based advertisement replacement system and methodology for *replacing advertising content on web-based communications received by users*. [Emphasis added.]" (Abstract of the Granik publication) Specifically, the section of the Granik publication, cited by the Examiner, states:

> Particularly, in response to a user click on a replaced ad, a web-based communication 32 is generated that includes a re-direct ad URL including: 1) an encrypted identifier that identifies the user on the re-direct server; and 2) an ultimate destination website code.

(Paragraph [0043] of the Granik publication) By contrast, the section of the Tomita publication, cited by the Examiner, provides:

> When the CPU 201 judges that firmware is attached (step S126, Yes), it extracts the part in the body section that corresponds to the firmware (step S127). As has been described, the data of the firmware has been converted to US-ASCII code according to Base 64 conversion in order to be attached to the e-mail. Therefore, the CPU 201 converts the character string back to binary data according to reverse Base64 conversion (step S128), and then stores the resulting

-18-

binary data in the hard disk drive
205 (step S129).

(Paragraph [0213] of the Tomita publication)   Thus, the
Tomita publication is discussing a system and method of
*implementing firmware updates in coordination with image
processing jobs in an image processing apparatus*.
Firmware data is "converted to US-ASCII code according to
Base 64 conversion" and sent via e-mail to the image
processing apparatus which then converts it back to
binary data.   (See Abstract and paragraphs [0018] and
[0213] of the Tomita publication.)

Neither the Granik publication, nor the Tomita
publication, contains any teaching, suggestion, or
motivation (nor is there any obvious reason) to combine
these disparate references as proposed by the Examiner to
produce the claimed invention. That is, one skilled in
the art would not have combined a system *for replacing
advertising content on web-based communications received
by users* with a system *for implementing firmware updates
in coordination with image processing jobs* in an image
processing apparatus. Since there is no obvious reason
to combine the references, this rejection is apparently
based on information from the applicants' own
disclosure -- that is, based upon improper hindsight
reasoning. The Examiner should only take into account
"knowledge which was within the level of ordinary skill
in the art at the time the claimed invention was made and
does not include knowledge gleaned only from applicant's
disclosure...." (*In re McLaughlin* 443 F.2d 1392, 1395,
170 USPQ 209, 212 (CCPA 1971).)

-19-

Consequently, claims 10 and 29 are not rendered obvious by the cited references for at least this first reason.

Second, regardless of the absence or presence of motivation to combine, claims 10 and 29 are not rendered obvious by the Granik and Tomita publications because the cited references do not teach, or suggest, acts of (or means for) (a) representing each of one or more ad properties of an ad with a binary value, (b) concatenating each of the one or more binary values to define a sequence of bits, (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters, and (d) providing the sequence of characters in a click URL of the ad.

In rejecting claims 10 and 29, the Examiner cites paragraph [0213] of the Tomita publication as teaching that "it is well known to encode binary data and parameters as a string of valid characters" and therefore teaches elements (a) through (c) in claims 10 and 29. (See Paper No. 20080702, page 5.) In addition, the applicants note that, although not explicitly stated, the Examiner is apparently using the purported teachings of the Granik publication as teaching element (d) of claims 10 and 29. The applicants respectfully disagree.

The Tomita publication concerns an image processing apparatus having a printer controller which "receives firmware attached to e-mail from a mail server, downloads the firmware to an internal hard disk drive, and registers the job at the bottom of a job registration table." (Abstract of the Tomita publication)

-20-

Specifically, as discussed above, the portion of the Tomita publication cited by the Examiner provides:

> When the CPU 201 judges that firmware
> is attached (step S126, Yes), it
> extracts the part in the body section
> that corresponds to the firmware
> (step S127). As has been described,
> the data of the firmware has been
> converted to US-ASCII code according
> to Base 64 conversion in order to be
> attached to the e-mail. Therefore,
> the CPU 201 converts the character
> string back to binary data according
> to reverse Base64 conversion (step
> S128), and then stores the resulting
> binary data in the hard disk drive
> 205 (step S129).

(Paragraph [0213] of the Tomita publication)   The Tomita publication is discussing a system and method of implementing firmware updates in an image processing apparatus.   Firmware data is "converted to US-ASCII code according to Base 64 conversion" and sent via e-mail to the image processing apparatus which then converts it back to binary data.   As can be appreciated from the foregoing, the Tomita publication does <u>not</u> teach or suggest (a) *representing each of one or more ad properties of an ad with a binary value*, (b) concatenating each of the one or more binary values to define a sequence of bits, and (c) encoding the sequence of bits into a sequence of characters, wherein each of the characters is selected from a set of K legal characters.   Rather, the Tomita publication merely converts firmware data into "US-ASCII code according to Base 64 conversion in order to be attached to the e-mail."   (Paragraph [0213] of the Tomita publication)   The

-21-

Tomita publication has nothing to do with representing ad
properties of an ad in binary value. Furthermore, the
purported teachings of the Granik publication fail to
compensate for the deficiencies of the Tomita publication
discussed above.

Thus, claims 10 and 29 are not rendered obvious by
the Tomita and Granik publications for at least this
second reason. Since claims 11, 12 and 19 depend from
claim 10, and since claims 30, 31 and 38 depend from
claim 29, these claims are similarly not rendered obvious
by the cited references.

Claims 13-18 and 32-37 stand rejected under 35
U.S.C. § 103(a) as being unpatentable over the Granik and
Tomita publications, further in view of "RFC 2396". The
applicants respectfully request that the Examiner
reconsider and withdraw this ground of rejection in view
of the following.

Claims 13-18 and 32-37 depend, either directly or
indirectly, from claims 10 and 29, respectively. The
purported teachings of RFC 2396 would not compensate for
the deficiencies of the Granik and Tomita publications
with respect to claims 10 and 29 (discussed above),
regardless of the scope of the purported disclosure in
RFC 2396, and regardless of the absence or presence of an
obvious reason to combine these references.
Consequently, claims 13-18 and 32-37 are not rendered
obvious by the cited references for at least this reason.

-22-

Claim amendments

Claims 20, 23, 29 and 38 have been amended to replace means-plus-function elements and to include one or more processors, at least one input, and one or more storage devices storing processor-executable instructions which, when executed by one or more processors, perform a method. This amendment is supported, for example, by Figure 6 and page 15, line 6 through page 16, line 10 of the present application.

Entry of Amendments

Since the amendments raise no new issues, the applicants respectfully request that these amendments be entered.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain *only* to the specific aspects of the invention *claimed*. Any claim amendments or cancellations, and any arguments, are made *without prejudice to, or disclaimer of*, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by

-23-

way of a continuation or divisional patent application
for example.

Since the applicants' remarks, amendments, and/or
filings with respect to the Examiner's objections and/or
rejections are sufficient to overcome these objections
and/or rejections, the applicants' silence as to
assertions by the Examiner in the Office Action and/or to
certain facts or conclusions that may be implied by
objections and/or rejections in the Office Action (such
as, for example, whether a reference constitutes prior
art, whether references have been properly combined or
modified, whether dependent claims are separately
patentable, etc.) is not a concession by the applicants
that such assertions and/or implications are accurate,
and that all requirements for an objection and/or a
rejection have been met. Thus, the applicants reserve
the right to analyze and dispute any such assertions and
implications in the future.

Respectfully submitted,
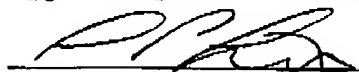
November 13, 2008

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-24-

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Signature   Date

-25-